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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/481,069 | | ALEXANDER BAKMAN | 21/99 | 5153 |

7590 10/09/2003

SUGHRUE MION ZINN MACPEAK & SEAS PLLC
2100 PENNSYLVANIA AVE NW
WASHINGTON, DC 20037-3213

EXAMINER

PAULA, CESAR B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2178

DATE MAILED: 10/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/481,069

Applicant(s)

BAKMAN ET AL.

Examiner

CESAR B PAULA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-113 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-113 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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Election/Restrictions

1. This action is responsive to the appeal brief filed on 6/4/2003.
2. Claims 1-113 are pending in the case. Claims 1, 8, 18, 36, 39, 43, 49, 59, 67, 78, 80, 86, 91, 94, and 95 are independent claims.
3. The rejections of claims 1-30, 32-41, 43, 45-58, 60-77, 78-90, 96-106, and 108-111 under 35 U.S.C. 103(a) as being unpatentable over Isaacson et al (Pat. # 6,065,116, 5/16/2000, filed on 5/7/1997), in view of Danknick et al (Pat. # 5,901,286, 5/4/1999, filed on 11/15/1996) have been withdrawn.
4. The rejection of claim 31 under 35 U.S.C. 103(a) as being unpatentable over Isaacson et al, in view of Danknick et al, and further in view of Noble et al (Pat. # 5,978,842, 11/2/1999, filed on 7/18/1997) has been withdrawn.
5. The rejections of claims 42, and 44 under 35 U.S.C. 103(a) as being unpatentable over Isaacson et al, in view of Danknick et al, and further in view of Noble et al (Pat. # 5,978,842, 11/2/1999, filed on 7/18/1997) have been withdrawn.

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6. The rejection of claim 59 under 35 U.S.C. 103(a) as being unpatentable over Isaacson et al, in view of Danknick et al, and further in view of Dunphy et al (Pat. # 5,638,509, 6/10/1997, filed on 6/13/1996) has been withdrawn.

7. The rejections of claims 91-95, 107, and 112-113 under 35 U.S.C. 103(a) as being unpatentable over Danknick et al have been withdrawn.

However, upon further consideration, the Examiner has determined that the claims contain multiple inventions, and therefore a restriction is included below.

8. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-7, 19-38, 49-54, 58, 61-66, 68-79, 91-98, 102, 107-108, 110, and 112-113 are drawn to the automatic production of documentation of configurable systems over the Internet, classified in class 715, subclasses 500, 513, and class 717, subclass 123.

Group II. Claims 8-18, 43-48, 55-57, 60, 67, 86-90, 99-101, 103, and 105-106 are drawn to automatic production of documentation of configurable systems using an index or a table of content, classified in class 707, subclass 1, and class 715, subclasses 500, and 531.

Group III. Claims 39-42, 80-85, 109, and 111 are drawn to the automatic

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production of documentation of configurable systems using a data parser, classified in class 715, subclasses 500, 513, and class 709, subclasses 200-203.

Group IV. Claims 59, and 104, are drawn to automatic production of documentation of configurable systems using an activity log, classified in class 707, subclass 10, and class 709, subclasses 216-217, and 219, 715, and class 715, subclass 500.

The inventions are distinct, each from the other because of the following reasons:

9. Inventions I, II, III, and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as the construction of table of content, and index to organize the document, and its parameters. See M.P.E.P. 806.05(d).

Moreover, invention III has separate utility such as the use of a data parser for parsing the documentation, and merge the parameters into a template. See M.P.E.P. 806.05(d).

Moreover, invention IV has separate utility such as the use of an activity log for logging retrieval, and outputting of parameters, and text respectively. See M.P.E.P. 806.05(d).

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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11. Because the inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IV, search for Group II is not required Groups I, III, and IV, search for Group III is not required for Groups I, II, and IV, search for Group IV is not required for Groups I-III.
12. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

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Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label **"PROPOSED"** or **"DRAFT"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).



CESAR B PAULA
Patent Examiner
Art Unit 2178

9/24/03